

REMARKS

Applicant respectfully traverses the rejection set forth in the July 12, 2004 Office Action.

First, it is respectfully submitted that claim 1 is directed to statutory subject matter in compliance with 35 USC § 101. It is further respectfully submitted that the Examiner has not made a proper prima facie case with respect to the obvious-type double patenting rejection.

With respect to the reference-based rejections, it is respectfully submitted that the Examiner misconstrues some claim language, as well as mischaracterizing some of the references, thus failing to make a proper prima facie case of obviousness. In addition, at least some of the motivation advanced by the Examiner is improper, resulting from hindsight reasoning.

For at least these reasons, as discussed in detail below, it is respectfully submitted that the Examiner's rejections are improper, and it is requested that the Examiner's rejections be withdrawn.

Statutory Subject Matter

The Examiner rejects claim 1 as being directed to non-statutory subject matter. While the Examiner references the discussion of computer-related inventions in MPEP 2106, the Examiner fails to clearly point out into which category of non-statutory subject matter discussed therein the claim 1 material is considered to fall.

MPEP 2106 specifically states (at page 2100-15 in the May 2004 revision) "To be statutory, a computer-related process must . . . (B) be limited to a practical application within the technological arts (discussed in ii) below)." MPEP 2106 further specifically states (at page 2100-18) "A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e., the method recites a step or act of producing something that is concrete, tangible and useful."

MPEP 2106 states one example of such a process that is statutory is particularly relevant:

"A computerized method of optimally controlling transfer, storage and retrieval of data between cache and hard disk storage devices such that the most frequently used data is readily available."

The subject matter of claim 1 is, in some sense, similar to the MPEP 2106 example in that the subject matter of claim 1 is directed to controlling transfer of HTTP response data from an in-kernel HTTP cache -- a concrete, tangible and useful result.

Unfortunately, since the Examiner has merely stated parts of the criteria set forth in MPEP 2106, without actually applying these criteria to Applicant's claim 1, it is impossible to squarely address the Examiner's contentions. (For at least this reason, the Examiner has failed to state a proper prima facie case of non-statutory subject matter.)

However, as set forth above, it is respectfully submitted that the method recited in claim 1 is suitably limited to a practical application and, as a result, is directed to statutory subject

matter. Given this, and also the Examiner's failure to support the rejection in any event, Applicant thus respectfully requests the Examiner to withdraw the rejection under 35 USC § 101.

Obviousness-Type Double Patenting

The Examiner has rejected claims 1, 25 and 26 as being unpatentable over various claims of U.S. Patent No. 6,668,279 (the '279 patent). An obviousness-type double patenting rejection is proper only where the subject matter of the rejected claims is obvious over the subject matter of claims in an issued patent.

The Examiner is respectfully reminded of the provisions of MPEP 804 (at page 800-22 of the August 2001 revision), that:

"Any obviousness-type double patenting rejection should make clear: (A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent." (emphasis added)

Here, the Examiner has pointed out what are alleged to be *similarities* between the subject matter of the rejected claims and the subject matter of the claims of the '279 patent. However, the Examiner does not even discuss the *differences*. It thus follows that the Examiner does not make any allegations (supported or unsupported) that there are differences that are obvious differences.

If the Examiner is contending that an "advisory state indicator" is obvious in view of a "preempt indicator," the Examiner does not say this — the Examiner says that these are "the same means." If the Examiner meant to say that an "advisory state indicator" is an obvious variation of a "preempt indicator," the Examiner does not provide any reasons whatsoever for such a statement. Without stating such reasons, the obviousness-type double-patenting rejection is improper on its face.

It can be seen, then, that the Examiner has failed to set forth a case at all of obviousness-type double patenting, let alone a proper prima facie case of obviousness-type double patenting. Applicant thus respectfully requests the Examiner to withdraw the obviousness-type double patenting rejection.

Art-Based Rejections

Gopal and Blumenau (Claim 1)

Claim 1 is rejected as being obvious over the combination of Gopal and Blumenau. It is respectfully submitted that the Examiner has improperly interpreted the scope of claim 1 and, therefore, has not made a proper prima facie case of obviousness. In addition, it is respectfully contended that the Examiner has not set forth a proper motivation to combine the Gopal and Blumenau references.

With regard to claim interpretation, the Examiner has noted (in the "Response to arguments" section of the Office Action) that the term "HTTP cache" in claim 1 is interpreted by the Examiner as merely a "cache." The Examiner contends that this is within the "broadest reasonable interpretation in light of the specification," referencing MPEP 2111.

MPEP 2111 discusses that, during prosecution, the Examiner does not necessarily need to consider limitations not explicitly recited in the claims, since the Applicant always has the opportunity to amend the claims during prosecution. This is not to say, though, that the Examiner may ignore features that are recited in the claims. In the specific example discussed in MPEP 2111, the Examiner considered the scope of the process steps recited in the claims to include a mental process augmented by pencil and paper. This is even though the Applicant was advocating that the claim was limited to being performed in a machine. The Federal Circuit agreed with the PTO that "the claim was not limited to using a machine to carry out the process since the claim *did not explicitly* set forth the machine."

In the present application though, claim 1 explicitly sets forth an "HTTP cache" and not merely a "cache." MPEP 2111 does not counsel the Examiner to ignore explicit language recited in the claims (as the Examiner has done here) but, rather, counsels the Examiner not to import language *not* explicitly recited in the claims. Thus, the Examiner must consider the cache recited in claim 1 to literally cover an HTTP cache.

The Examiner has also stated in the "Response to Arguments" section of the Office Action that "requesting permission from an HTTP daemon" is not recited in rejected claim 1, contrary to what the Applicant allegedly contends. What Applicant actually contended with regard to this feature is (with underlining in original):

Hayes neither discloses nor suggests requesting permission from a HTTP daemon in order to transmit data obtained from an in-kernel HTTP cache. Specifically, Hayes neither discloses nor suggests obtaining an advisory state indicating whether it is necessary to obtain permission from the HTTP daemon.

To paraphrase, Applicant contended that, since Hayes does not disclose or suggest requesting permission from a HTTP daemon, Hayes certainly does not disclose or suggest indicating whether it is necessary to obtain permission from the HTTP daemon. "Obtaining an advisory state" is certainly explicitly recited in claim 1, as is that "the advisory state when in a first state indicating that it is necessary to obtain permission from a HTTP daemon . . ." Put another way, Applicant was contending that, if Hayes does not disclose or suggest requesting permission from a HTTP daemon, Hayes certainly does not disclose or suggest obtaining an indication of whether it is necessary to obtain such permission. Applicant was not arguing that claim 1 recites requesting permission from a HTTP daemon.

Clearly, the Examiner's misinterpretation of the scope of claim 1 (and/or Applicant's arguments with respect to claim 1) has tainted the prior art rejections, since properly interpreting the scope of a claim is a required condition to advancing a proper rejection over prior art.

We now turn to the Examiner's application of the Gopal and Blumenau references to claim 1. In applying the Gopal and Blumenau references to claim 1, the Examiner does not even contend that either reference discloses:

1. "determining whether response data is in the in-kernel, HTTP cache;" and
2. "obtaining an advisory state" that "when in a first state indicating that it is necessary to obtain permission from a HTTP daemon to determine whether the response data can be transmitted."

Thus, for at least the reason that the Examiner has not alleged that the cited references disclose or suggest all of the features recited in claim 1, the Examiner has failed to set forth a proper prima facie case of obviousness.

In addition, the Examiner's cited motivation for combining the disclosure of Gopal and Blumenau is deficient. In particular, it is well settled that, for a proper prima facie case of obviousness, the prior art itself must suggest the desirability of the claimed subject matter. The Examiner is referred, for example, to MPEP 2143.01. There, it is discussed that the source of the motivation must be the cited references themselves or knowledge held by one of ordinary skill in the art. Furthermore, the Examiner is reminded that "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure." See MPEP 2143.

Here, the Examiner has pointed to nothing in the references or knowledge held by one of ordinary skill in the art that would suggest the alleged combinations of references. A bold assertion that the teachings of a secondary reference would improve the teachings of a primary reference (essentially what the Examiner has asserted) are insufficient, even if such an assertion turns out to be true. The Examiner has not pointed to anything in the references or knowledge held by one of ordinary skill in the art suggesting or motivating the alleged improvement. Therefore, the Examiner must be relying on the impermissible hindsight gleaned from Applicant's disclosure, and the obviousness rejection is insufficient for this reason, too.

The Examiner has improperly construed claim 1 in applying the disclosure of the cited references. The Examiner also has not provided a proper motivation to combine the references. Therefore, the rejection is unsupported by the cited references and should be withdrawn.

Hayes, Hunt and Blumenau (Claims 1-7 and 24-26)

Claim 1-7 and 24-26 are rejected as being obvious over the combination of Hayes, Hunt and Blumenau. It is respectfully submitted that the Examiner has improperly interpreted the scope of claim 1 and, therefore, has not made a proper prima facie case of obviousness. In addition, it is respectfully submitted that the Examiner has mischaracterized the cited references in any event.

We first address Applicant's contention that the Examiner has improperly interpreted the scope of claim 1. This contention has been discussed fully above and, as such, is not discussed

in detail here. However, it is not clear from the rejection of claims 1-7 and 24-26 if the Examiner is now considering, with respect to this rejection, that claim 1 includes subject matter involving a HTTP cache. The Examiner does allude to a contention that Hunt discloses a "HTTP" cache, but it is not clear from the text of the rejection if this is an actual contention or if HTTP is stated in quotation marks merely to indicate that the Examiner recognizes the word "HTTP" appears in the claim, even though the Examiner again interprets this recitation as merely a "cache." To the extent the Examiner, in making the present rejection, does not consider the subject matter of claim 1 to involve a HTTP cache, Applicant respectfully submits that, for at least this reason, the Examiner has failed to set forth a proper prima facie rejection.

With respect to the cited references, Applicant specifically addresses the Examiner's reliance on the Hunt reference. In the "Response to arguments" section of the Office Action, the Examiner has stated that col. 4, lines 46-57 of Hunt explicitly suggests "that the cache may be configured to reside on a server for caching web pages, i.e., a web server." However, the portion of Hunt cited by the Examiner actually recites that "a client system running a browser application may configure the browser cache to reside on a remote file server." Contrary to the Examiner's apparent suggestion, the "remote file server" is not disclosed as being a "web server."

In fact, the "remote file server" concept is discussed in Hunt as follows (see col. 4, lines 46-54):

With reference now to FIG. 3, one possible example of a data structure employed in remotely caching Web pages at a shared server in accordance with a preferred embodiment of the present invention is depicted. It is common practice in virtually all data processing system architectures and operating systems that remote file input/output (I/O) subsystems provide access to remote files in a local/remote transparent manner, such that applications requiring access to remote files do not distinguish between remote and local files. Given this behavior, a client system running a browser application may configure the browser cache to reside on a remote file server.

Clearly, the "cache" referred to in this section, whether located on the client system or on a remote file server, is a "browser cache" and not a web server HTTP cache. Applicant did not contend that Hunt "does not teach a cache in a server," as the Examiner contends. Applicant actually contended that "Hunt fails to disclose or suggest managing a HTTP cache (e.g., in-kernel HTTP cache) in a web server." (emphasis in original) A browser cache, whether located locally or remotely, is not "an in-kernel HTTP cache in a web server".

The "advisory state" supposedly disclosed by Blumenau is not even alleged to ever indicate that it is necessary to obtain permission from a HTTP daemon for anything, let alone to determine whether the response data can be transmitted. Rather, the Examiner only alleges that the Blumenau flag "indicates that all resources are private and no permission is needed from a lock manager before the host controller port can accessing [sic] any of the resources its [sic] assigned resource list." Thus, the Examiner has failed to set forth a proper prima facie case of obviousness since there is no assertion with regard to the HTTP daemon.

Of course, as discussed above, the Examiner has asserted that there is no recitation in claim 1 with regard to "requesting permission from a HTTP daemon." As also discussed above, Applicant respectfully submits that the Examiner is not free to ignore the feature explicitly recited in the claims - "the advisory state when in a first state indicating that it is necessary to obtain permission from a HTTP daemon . . ." This claim does not recite the advisory state "indicates that all resources are private . . ." as the Examiner asserts that Blumenau discloses, therefore the Examiner's assertion with respect to Blumenau is irrelevant to a proper prima facie case of obviousness.

Thus, it has been shown that the Examiner has misconstrued the scope of the claim recitation beyond a reasonable interpretation. Furthermore, it has been shown that at least some of the cited references do not disclose what the Examiner says they disclose. Finally, and related to the showing that the Examiner has misconstrued the scope of the claim recitation, it has also been shown that the Examiner has not applied the references to the true claim scope.

It is respectfully submitted that, at least for these reasons, the Examiner has failed to advance a proper prima facie case of obviousness with respect to Hayes, Hunt and Blumenau. While the above discussion has, in some respects, been specific to claim 1, the discussion is also applicable to the independent claims 24, 25, and 26 and to claims 2-7, dependent on claim 1.

Conclusion

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
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